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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDRICKS, KEITH D

ART UNIT PAPER NUMBER

1761

DATE MAILED: 03/25/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,425

Applicant(s)

STAHL, BRONISLAW-JAN

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) 1-27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

NOTE: *This application is an English translation of a foreign document. Applicants' representative is strongly encouraged to review the application, especially the claims, to comply with accepted U.S. Patent structure and language. The claims are generally narrative and indefinite, failing to conform with current U.S. practice, and are replete with grammatical and idiomatic errors. The rejections under 35 USC 112 2nd paragraph below are an attempt to call attention to these occurrences, yet may not be comprehensive.*

The following occur in numerous instances within the rejected claims, and should be corrected consistently throughout. Note that certain of applicants' claims have been amended under Article 34 from the original international filing, yet applicants have not amended all claims to correspond to these amendments, creating a situation where it is difficult to examine and ascertain the scope of the claimed invention, including considerations of prior art.

The use of the phrase "vegetable flavouring" is confusing, as this appears to include both fruit and vegetable flavoring sources. It is believed that applicant intends this to mean "plant", or "fruit or vegetable" flavorings, yet this is unclear from the claims.

The phrase "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Similarly, the phrases "preferable", "preferably", "more preferred" and "most preferred", are indefinite.

The phrase "high potent sweeteners" is indefinite. Although the specification, at page 8, provides examples of what are included by the phrase "high potent sweeteners", it does not provide a sufficient definition such that one skilled in the art would be apprised of the metes and bounds of the claims. It is unclear as to what sweeteners, or at the least, what types of sweeteners, would be encompassed by this phrase. For example, it is unclear if sugar alcohols such as xylitol, are encompassed by this phrase, as these may be considered "high potent sweeteners" due to their relative sweetness as compared to sucrose.

In claim 3, the recitation of the Markush-type grouping is improper. For example, at line 5, the recitation of "...gooseberry, and lingoberry thyme, basil" is unclear and improper.

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Claim 10 recites an improper Markush-type grouping, with the recitation of the phrase "comprises seeds from a fruit from strawberry, blackberry and raspberry". Open language in claims should be in the alternative only ("or").

Similarly, in claim 12, the phrase "and fruit flavors such as" is suggested to be deleted, to maintain a proper Markush-type grouping of elements.

In claim 14, it is unclear to what element, or elements, the phrase "and salts thereof" pertains.

Claims 17, 20 and 22 improperly set forth a Markush-type grouping, where the metes and bounds of the phrase "selected among", are unclear.

Note that in claim 17, the recitation of "preferably a mixture of fatty substances and carnauba wax" is indefinite, because it is unclear whether the limitations following the term "preferably" are part of the claimed invention. See MPEP § 2173.05(d).

Similarly, claim 20 recites several instances of the terms "and" and "such as", within the grouping set. Note that applicants' preliminary amendment did not set forth the precise elements to be deleted, and thus the elements that were deleted -- as instructed -- in the claims, were "such as" (twice), "aloe vera", and "tomato". Again, applicants are strongly reminded of careful and specific amendment to the claims.

Claim 15 is dependent upon claim 1, and is directed to a chewing gum wherein "the functional substances" are provided. However, there is insufficient antecedent basis for this limitation in claim 1.

In claim 18, it is unclear as to how a chewing gum coating, which according to the teachings of the specification is presumably hardened, may additionally comprise "one or more liquid active substance(s)." Further, it is unclear as to how one skilled in the art is to determine if a liquid substance is "active", as the metes and bounds of this phrase are not set forth in the claims or specification.

Claim 19 is indefinite and confusing, as this appears to -- at least in part -- overlap and conflict with the recitation of claim 1. Claim 1 provides a possible limitation of "vegetable flavoring agents", where claim 19 "further" comprises "natural, naturally identical or synthetic flavours, and plant extracts". The metes and bounds of the claimed invention are unclear.

Further, it is unclear as to what is encompassed by the phrase "naturally identical... flavours", and how these are distinguished from the other elements in claim 19.

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In claim 21, it is unclear if the salt is to be part of the coating, or may be located elsewhere in the coated chewing gum product, such as within the core.

Claim Objections

Claims 1-27 are objected to because of the following informalities, which appear in numerous claims. Appropriate correction is required.

- Several of applicants' preliminary amendments do not correspond to the actual claims, thus leaving the claims both incomplete and grammatically incorrect. Careful review of each of the previously submitted amendments, as well as any subsequent amendments, is strongly suggested. For example, the preliminary amendments to claims 8 and 9 render the claims incomplete, as these phrases are not specifically found within the claims.
- In claim 12, line 2, the phrase "natural vegetable" is underlined, improperly.
- The phrase "characterized in" fails to positively define a limitation of the claimed product; it is suggested that the phrase be amended to the term "wherein".
- Applicants' amendment of the phrase "selected among", to "selected group consisting of", is grammatically incorrect. The claims should read "selected from the group consisting of".
- The term "flavouring" should be spelled "flavoring", and other such terms (such as "colour" in claim 11, etc.) should be written in accordance with standard U.S. spelling.
- In claim 19, the term "[is]", including brackets, is improperly set forth within the claim.

Claims 23-27 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should (a) refer to claims in the alternative only, and (b) should not depend from another multiple-dependent claim. See part (4) of the claim. *Accordingly, the claims 23-27 have not been further treated on the merits.* See MPEP § 608.01(n).

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

i) Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tyrpin et al. (US PAT 5,603,970).

Tyrpin et al. disclose a "chewing gum pellet coated with a hard coating". The coating may contain natural or synthetic flavors from plants and fruits, providing such flavors from citrus oils, fruit essences, peppermint oil, spearmint oil, clove oil, etc. (col. 5-6). Further, high intensity sweeteners such as aspartame, sucralose, or saccharin salts, may be used, either uncoated or in encapsulated form.

It is noted that claims 2-15 do not specifically require that any of the natural vegetable flavoring agent, the acid, the sweetener or the "functional substances" be selected from claim 1. The claims only further limit claim 1 by requiring that, *if selected*, the limitations in claims 2-14 be met. Note that the claims may be amended to recite "the coated chewing gum according to claim 1, wherein the active substance is a natural vegetable flavoring" (or acids, or high potent sweeteners), and then continue to further define these positively-recited limitations. Thus, as it stands, a reference providing for the inclusion of an encapsulated high-intensity sweetener meets the limitations set forth in claims 1-22.

ii) Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Cherukuri et al. (US PAT 4,250,195, of record in IDS).

Cherukuri et al. disclose a method for producing a coated chewing gum, wherein the chewing gum is coated with a series of syrups, containing flavorings, sweeteners, bulking agents, etc. Column 4 of the reference discloses the application of flavorings, either in natural form, synthetic form, or as spray-

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dried flavorings. Spray-dried flavorings are either added with the dusting mix after an application of the syrup coating, or after the syrup and dusting mix is applied. The coating flavorings are present in amounts of about 0.5 to 5% of the coating, and "comprise oils derived from plants, leaves, flowers, fruit, etc." Such flavors include various citrus flavors, peppermint, spearmint, apple, cherry, strawberry, etc. As spray-dried flavors are in powdered form, these meet the limitations of the instant claims.

It is noted that claims 2-15 do not specifically require that any of the natural vegetable flavoring agent, the acid, the sweetener or the "functional substances" be selected from claim 1. The claims only further limit claim 1 by requiring that, *if selected*, the limitations in claims 2-14 be met. Note that the claims may be amended to recite "the coated chewing gum according to claim 1, wherein the active substance is a natural vegetable flavoring" (or acids, or high potent sweeteners), and then continue to further define these positively-recited limitations. Thus, as it stands, a reference providing for the inclusion of a spray-dried natural fruit flavor meets the limitations set forth in all claims 2-15.

iii) Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel et al. (EP 0 435 698, of record in IDS).

Patel et al. disclose a chewing gum coated with an outer shell. This outer shell includes a powdered rolling compound, which may comprise a flavoring ingredient "including spray-dried flavors, encapsulated flavors... high potency sweeteners such as aspartame" (pg. 3). The reference states that the liquid flavor may be selected from such items as spearmint oil, peppermint oil, fruit flavors, etc.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



KEITH HENDRICKS
PRIMARY EXAMINER